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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/369,490	08/05/1999	ERIC O. BODNAR	SF/0027.01	6852

22470 7590 09/16/2003

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EXAMINER

ZIA, SYED

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 09/16/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/369,490

Applicant(s)

BODNAR, ERIC O.

Examiner

Syed Zia

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) 1-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 24, 2003 (Paper No. 12) has been entered.

### ***Response to Amendment***

1. This office action is in response to amendment filed on June 24, 2003 (Paper No. 12). Original application contained Claims 1-50. Applicant cancelled Claims 1-50, and added Claims 51-76. The amendment filed have been entered and made of record. Presently pending claims are 51-76.

### ***Response to Arguments***

1. Applicant's arguments filed on June 24, 2003 (Paper No. 12) have been fully considered. Applicant's arguments with respect to Claims 51-76 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1-10, 12-14, 17-35, 37-39, 42-50 are rejected under 35 USC 102(e) as being anticipated Hoffman, Jr. et al., US Patent No. (6,122,657).

2. Regarding claim 51 and 64 Hoffman describe and teaches a system and method of receiving control messages at a client machine from a web server, using a parent process coupled with an embedded web browser, including:

- requesting a web page, the web page including one or more special key tags that include auxiliary information, the special key tags not defined in HTML but recognized by the parent process (col.26 line 58 to line 67);

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- receiving the web page (col.2 line 2 to line 6); processing the special key tags in the parent process, including triggering of special behavior by the client machine, and processing at least part of the web page other than the special key tags by the embedded web browser (col.8 line 33 to line 53, col.3 line 39 to line 54).

3. Claim 52, 54-60, 62, 65, 67-73, and 75 are rejected applied as above in rejecting claim 51 and 64. Furthermore, Hoffman teaches and describes a system and method wherein:

- processing by the parent process further includes reviewing a tag not defined in HTML before the tag is passed to the embedded web browser (col.26 line 58 to line 67);

- the special behavior by the client machine includes invoking a handler routine that responds to instructions in the auxiliary information (col.25 line 57 to line 67);

- the special behavior by the client machine includes running code responsive to the auxiliary information that is not part of the embedded web browser and not downloaded with the web page (col.7 line 39 to line 67);

- the special behavior by the client machine includes: presenting a dialog box not found in the web page, presenting a set-up dialogue for the parent process, customizing operation of the parent process, presenting a sign-on dialogue not found in the web page (col.4 line 47 to col.5 line 1), modifying a system registry entry corresponding to the parent process (col.3 line 14 to line 23), and publishing a user-specific web page (col.8 line 21 to line 33).

4. Claims 53, 61, 63, 66, 74, and 76 are rejected applied as above in rejecting 52, 60, 62, 65, 73, and 75. Furthermore, Hoffman teaches and describes a system and method wherein:

- the special key tags further include hypertext navigation information and processing by the parent process further includes passing the hypertext navigation information to the embedded browser in an HTML tag (col.5 line 29 to line 35, and col.7 line 48 to line 62).

- the special key tag that triggers modification of the system registry entry includes at least one name/value pair (col. 8 line 9 to line 17, and col. 2 line 18 to line 25);

- publishing the user-specific web page includes making a specific HTTP request that includes information known to the parent process (col.8 line 21 to line 33).

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*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Zia whose telephone number is 703-305-3881. The examiner can normally be reached on Monday - Friday 9:00 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-746-7240.

SZ

September 8, 2003

AYAZ SHEIKH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100